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FROM:	Ernest J. Beffel, Jr.	
CLIENT/MATTER:	Application No. 09/173,858 (JGR 1004-1)	
DATE:	26 June 2005	

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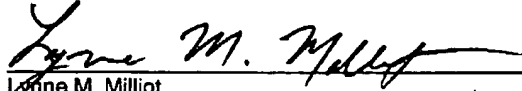
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Atty Docket No. JGR 1004-1

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Lynne M. Milliot

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JUN 26 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bart Alan MELTZER et al.

Application No. 09/173,858

Confirmation No. 4734

Filed: 16 October 1998

Title: **Documents for Commerce in Trading Partner
Networks and Interface Definitions Based on
the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO. 22470

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL OF STATEMENT OF SUBSTANCE OF INTERVIEW

Sir:


In connection with the above-referenced U.S. patent application, transmitted herewith is following paper:

☒ Statement of Substance of Interview

Authorization is given to charge Deposit Account No. 50-0869 (JGR 1004-1), or credit any payment thereto, for any fees associated with this document.

Respectfully submitted,

Dated: 26 June 2005


Ernest J. Beffel, Jr.
Registration No. 43,489

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Application No. 09/173,858

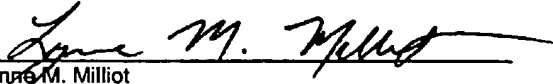
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STATEMENT OF SUBSTANCE OF INTERVIEW

Sir:

In response to the Interview Summary mailed 10 June 2005 in the above-referenced application, Applicants hereby submit this Statement of Substance of Interview held on 07 June 2005.

Should it be determined that any fees are required with regard to the filing of this document, the Commissioner is hereby authorized to charge those fees to Deposit Account No. 50-0869 (JGR 1004-1).

Applicants appreciate the Special Program Examiner's effort to prepare an interview summary and take this opportunity to supplement the summary. We particularly appreciate the Special Project Examiner's statements which refute substantially all of the Examiner's grounds for not accepting the declarations and

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approve the substance of the declarations as removing the reference. However, we supplement the interview summary so that there is no appearance that the Special Programs Examiner is claiming expertise in judging the sufficiency of efforts to contact an unavailable inventor, in light of his disavowals of expertise on the particular issue made during our interview.

First, the Examiner did not reject the declarations of four inventors and did not even acknowledge that four inventors had submitted declarations. This was discussed.

Second, the Examiner did not criticize the statements in one of the declarations regarding the unavailability of the fifth inventor. She did not even mention the issue. This also was discussed. It was not a basis for the Examiner's rejection and would be a new grounds of rejection on appeal, if asserted by the Examiner.

Third, the Special Program Examiner acknowledged that he was unfamiliar with the standard by which efforts to reach the fifth inventor would be judged. He suggested that we contact the Office of Petitions for more information, but we agreed that the pending appeal would be likely to resolve the issue. In the present interview summary, the Special Program Examiner acknowledges that the procedures for signing an oath on behalf of a missing inventor do not apply to a Rule 131 petition.

During our interview, we directed the Special Program Examiner's attention to *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935), on which MPEP § 715.04 relies. The Special Program Examiner indicated that he was unfamiliar with *In re Carlson* when we spoke, and the present interview summary makes no reference to the controlling case. As indicated in our Appeal Brief, the declarations make a stronger showing of inventor unavailability than was required by the *In re Carlson* court. (We suggested that the Special Programs Examiner review the Appeal Brief and offered to provide a copy.)

Fourth, the declarations are acceptable to remove the reference, whether or not made by inventors, under *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903), relied on in MPEP § 715.04, because the declarations state the witnesses percipient knowledge. We have attached a copy of the case for the record.

Independent of the interview, we suggest that it would be helpful if the MPEP were updated to give examiners and applicants more guidance as to how to proceed


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under 37 CFR 1.131, as there is no statement (or even hint) of an need to make a petition to suspend the rules in these circumstances.

Respectfully submitted,

Dated: 26 June 2005


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Attorney for Patent Owner

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Jun. 26. 2005 2:25PM

Haynes Beffel Wolfeld LLP

No. 1147 P. 6

DECISIONS OF THE COMMISSIONER OF PATENTS. 213

MPEP 715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations

WHO MAY MAKE AFFIDAVIT OR DECLARATION
The following parties may make an affidavit or declaration under 37 CFR 1.131:

...
(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

purpose and for that reason voluntarily allowed the application to become abandoned. By that act the case was finally disposed of, and it cannot be revived by the amendment to the law.

The petition is denied.

EX PARTE FOSTER.

Decided May 18, 1903.

(105 O. G., 261.)

1. AFFIDAVIT UNDER RULE 75—AFFIDAVIT BY ASSIGNER.

Where the affidavit of the inventor under Rule 75 cannot be procured, the affidavits of the assignees and other parties may be received as competent evidence.

2. SAME—PRIORITY OF INVENTION—EVIDENCE.

The essential thing to be shown under Rule 75 is priority of invention, and this may be done by any satisfactory evidence of the fact.

3. SAME—RULE 75 CONSTRUED.

Rule 75 says that the affidavit of the inventor alone is sufficient to overcome a reference cited; but it does not say that the reference cannot be overcome in any other way.

4. SAME—AMOUNT OF EVIDENCE A MATTER OF DISCRETION.

Where no affidavit by the inventor is filed, the question what amount of proof will be regarded as sufficient to overcome a reference cited is a matter to be determined by the tribunal passing upon the case.

ON PETITION.

APPARATUS FOR DELIVERING FILLED BAGS TO SEWING MECHANISM.

Application of Charles H. Foster filed May 11, 1901, No. 59,822.

Messrs. Sturtevant & Greeley for the applicant.

Jun. 26. 2005 2:26PM

Haynes Beffel Wolfeld LLP

No. 1147 P. 7

214 DECISIONS OF THE COMMISSIONER OF PATENTS.

ALLEN, *Commissioner*:

This is a petition from the action of the Primary Examiner refusing to accept an affidavit filed in the above-entitled application under Rule 75.

It seems that the Examiner rejected a claim upon the disclosure of a prior patent, and in order to overcome that patent as a reference an officer of the company owning the invention filed an affidavit alleging that the inventor made the invention before the date of the application on which the patent issued. The showing in this affidavit was such that the Examiner says it would be received as satisfactory if it were made by the proper party. He contends, however, that under the express provisions of Rule 75 no one save the inventor can make the affidavit called for and that therefore the affidavit filed is incompetent.

The Examiner's action is in the form of a rejection of the claim and is therefore properly appealable to the Examiners-in-Chief. Strictly speaking, they should determine whether the patent is a reference, notwithstanding the affidavit filed; but it is believed that it is not improper to express now an opinion as to the competency of the affidavit without regard to its sufficiency.

Rule 75 says that a prior patent disclosing, but not claiming, the invention will not be a reference if "the applicant shall make oath" to certain facts. It is to be noted that the rule does not say that the patent cannot be overcome as a reference in some other way. In determining the meaning of the rule the purpose and end aimed at should be kept in mind. The purpose is clearly to permit the applicant to show that he made the invention prior to the patentee. The rule says that the inventor's affidavit will be sufficient; but it does not say that the fact may not be established in some other way. For instance, if the testimony taken in an interference proceeding showed invention by the applicant before the patentee's date it is very clear that there is no necessity for the affidavit provided for in Rule 75. (*Ex parte Keller*, C. D., 1892, 238; 61 O. G., 1790.) The essential fact is priority of invention, and the Office may accept any satisfactory evidence of that fact. Where it has no testimony or record evidence of the fact, it must of necessity accept *ex parte* affidavits. Where the testimony of the inventor cannot be obtained, priority may in some cases be proved without his testimony, and this is equally true of the *ex parte* showing of priority where testimony cannot be taken. Rule 75 says that when the inventor makes the affidavit no further proof is necessary. (*Ex parte Johnson*, C. D., 1899, 212; 89 O. G., 1241.) In the absence of such affidavit the question as to the amount of proof which will be regarded as sufficient is a matter for the judgment of the tribunal having jurisdiction of the question.

It is held that the affidavit filed in this case should be entered and considered, and to this extent the petition is granted.